



*Handwritten signature*

PATENT  
0696-0171P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant(s): Thomas GAROFF et al. Conf.: 4182  
Appl. No.: 09/582,321 Group: 1755  
Filed: August 22, 2003 Examiner: Jennine Brown  
For: SOLUBLE MAGNESIUM DIHALIDE COMPLEX,  
PREPARATION AND USE

TERMINAL DISCLAIMER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

June 12, 2003

Sir:

Borealis Technology Oy, (hereinafter "the Assignee")

- ☐ residing at ,  
☒ a corporation of FINLAND having a principal place of  
business at P.O. Box 330, FIN-06101, Porvoo, Finland,  
☐ a university having an address of ,

08/11/2003 MWAGSTAF 00000001 022448 09582321  
01 FC:1814 110.00 DA

represents that it is the true owner of the entire interest of  
U.S. patent Application No. 09/582,321, filed on August 22, 2000,  
for "SOLUBLE MAGNESIUM DIHALIDE COMPLEX, PREPARATION AND  
USE," (hereinafter "above-identified application") by virtue of  
and as evidenced by an Assignment recorded at the United States  
Patent and Trademark Office at Reel 11074, Frame(s) 0043-0045.

The Assignee hereby disclaims the terminal part of any  
patent granted on the above-identified application which would  
extend beyond the expiration date of the full statutory term as  
presently shortened by any terminal disclaimer of U.S. Patent

**BEST AVAILABLE COPY**

6,420,499, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to U.S. Patent 6,420,499 shall be the same as the legal title to any patent issuing from the above-identified application, this agreement to run with any patent granted on the above-identified application, and to be binding upon the grantee, its successors or assigns.

The Assignee does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent 6,420,499 in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

This Terminal Disclaimer is submitted on behalf of the Assignee by the undersigned, an attorney of record in the above-identified application.

Appl. No. 09/582,321

Please charge any fees or credit any overpayment pursuant to  
37 C.F.R. § 1.20 to Deposit Account No. 02-2448.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

Date: June 12, 2003

By

Andrew D. Meikle, #32,868

ADM/KJR/jmb  
0696-0171P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

Attachment(s)

(Rev. 04/30/03)

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM 09/58

DATE: 8-21-03

APPL S.N.:

EXAMINER: Dr. J. W. N.

ART UNIT:

PARALEGAL: DEBBIE THOMAS

MAILROOM DATE: 6-12-03

AFTER FINAL: YES \_\_\_ NO ☒

NUMBER OF T.D.(S) FILED: 1

**INSTRUCTIONS:** I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please see our Special Program Examiner or me.

**INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT. NOR**

**THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.**

- ☒ The T. D. is PROPER and has been recorded. (See 14.23)
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)
- ☐ The recording fee of \$\_\_\_\_\_ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)
- ☐ Application Examiner has not processed fee for T. D.
- ☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)
- ☐ The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)
- ☐ T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)
- ☐ The person who signed the terminal disclaimer:
- ☐ has failed to state his/her capacity to sign for the business entity. (See 14.28)
- ☐ is not recognized as an officer of the assignee. (See 14.29.1)
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72) NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)
- ☐ No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)
- ☐ The T. D. is not signed (See 14.26 and 14.26.3)
- ☐ Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)
- ☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)
- ☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)
- ☐ Other \_\_\_\_\_

**BEST AVAILABLE COPY**